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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,703	02/12/2004	Mark Depietro	D02981	5724

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EXAMINER
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FEATHERSTONE, MARK D

ART UNIT	PAPER NUMBER
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4157

NOTIFICATION DATE	DELIVERY MODE
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03/06/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.Schaumburg@motorola.com  
APT099@motorola.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/777,703	<b>Applicant(s)</b> DEPIETRO ET AL.	
	<b>Examiner</b> MARK D. FEATHERSTONE	<b>Art Unit</b> 4157	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 2/05/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-22 in the reply filed on 1/28/2008 is acknowledged.
2. Claims 1-22 are pending in this application. Claims 23-51 were canceled due to the restriction requirement.

### **Specification**

3. The disclosure is objected to because of the following minor informalities:  
  
Claim 5 recites the phrase "data 30 packets". The examiner is not familiar with this phrase, and assumes it was meant to say "data packets".  
  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of

an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English.

5. Claims 1-3, 8-9, 11, 12-14, 19-20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Birks et al, US PG Pub # 20030192054.

With regard to Claim 1, Birks discloses:

A method for expanding the functionality of a content receiver comprising the steps of:

Receiving a command from a downstream content receiver (paragraph 0017; Birks describes a set top box (i.e. content receiver) sending a request to a server upstream); and

Executing the command if the command is not directed to a server further upstream (paragraph 0034; Birks describes a content stream provided to a user upon request, thus executing the request command from the user)

With regard to Claim 2, Birks discloses:

The method of claim 1, further comprising the step of directing an unexecuted command to a server further upstream (Figure 1, item 110 and paragraph 0015; Birks clearly shows a separate billing component further upstream of the server, which would handle billing/management commands)

With regard to Claim 3, Birks discloses:

The method of claim 2, wherein the step of directing an unexecuted command to a server further upstream comprises the steps of:

Receiving data packets addressed to an upstream augmentation unit (figure 3, item 310 and paragraph 0028; Birks describes the process of receiving a content stream in one of many formats, which are intended to be stored further upstream in a storage server);

Generating a modulated carrier signal according to the data packets (figure 3, item 320 and paragraph 0029; Birks describes formatting the signal to a CBR stream);

Conveying the modulated carrier signal to an upstream interface (figure 3, item 330 and paragraph 0031; Birks describes sending the signal to a mass storage server, which is further upstream than the server that receives the content)

With regard to Claim 8, Birks discloses:

The method of claim 1, wherein the command received is a record command and the step of executing the command comprises the steps of:

Receiving a content stream from an upstream signal source, and recording the content stream (paragraph 0017, Birks describes that a program can be recorded on request, with the request propagating back through the network to the server)

With regard to Claim 9, Birks discloses:

The method of claim 1, wherein the command received is a play command and the step of executing the command comprises the steps of:

determining what content is requested for play; retrieving the requested content; and directing the retrieved content to the downstream content receiver

(paragraph 0042; Birks discloses a "play" command that causes the streaming of the stored program)

With regard to claim 11, Birks discloses:

The method of claim 9 wherein the step of directing the retrieved content to the downstream content receiver comprises the steps of:

Modulating the carrier signal according to the content stream; and

Conveying the modulated carrier signal to the downstream content receiver in lieu of a multiple carrier signal (paragraph 0034; Birks clearly discloses modulating the stream to a user upon request via a point-cast technique)

Claims 12-14, 19-20, and 22 are rejected as applied to claims 1-3 and 8-9, and 11 respectively. Birks discloses the system as well as the method of this concept.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;

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- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

7. Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Birks et al, US PG PUB # 20030192054” in view of “Handelman et al, US PG PUB # 20040016002”.

With regard to claim 4, Birks discloses the method of claim 1 (see claim 1 rejection); however, he fails to disclose the following:

further comprising the step of configuring a downstream content receiver to forward commands upstream if the downstream content receiver had not been previously configured to do so

Handelman, in his application discloses a system to reconfigure a consumer device from a remote location. In paragraph 0050, Handelman discloses a method of reconfiguring a downstream content receiver so that the reconfigured device is capable of executing an application on the communication network.

A person of ordinary skill in the art at the time of invention would have found it obvious to combine the system of Birks with the reconfiguration device of Handelman in order to create a device that handled commands from a subscriber device without the need to physically replace the subscriber device to add the functionality. The advantage of such a system would reduce costs associated with adding functionality.

Claim 15 is the apparatus to perform method claim 4, and is rejected on this basis.

8. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Birks et al, US PG PUB # 20030192054” in view of “Handelman et al, US PG PUB # 20040016002” in further view of Hamilton, US Patent # 7305357.

With regard to claim 5, Birks, in view of Handelman; discloses the method of claim 4 (see claim 4 rejection). However, they fail to specifically disclose the following:

The firmware patch that causes the processor to:

Fragment an unexecuted command into one or more data packets;

Generate a modulated carrier signal according to the data packets; and

Convey the modulated carrier signal to an upstream augmentation unit

Hamilton, in his patent, discloses a method of sending customer requests issued in the form of data packets forwarded over Ethernet to a server (column 15, lines 56-60).

A person of ordinary skill in the art at the time of invention would have found it obvious to add this feature to the system taught by Birks and Handelman as it is a known and widely used way to transfer data.

Claim 16 is the apparatus to perform method claim 5, and is rejected on this basis.



9. Claims 6-7 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Birks et al, US PG PUB # 20030192054” in view of Hamilton, US Patent # 7305357.

With regard to claim 6, Birks discloses:

The method of claim 1 (see claim 1 rejection), however he fails to specifically teach the following feature, which Hamilton does.

Wherein the step of receiving a command from a downstream receiver comprises the steps of: Receiving a data packet from a downstream interface according to a delivery address (column 15, lines 56-60; Hamilton discloses sending the command as a data packet, which inherently has to be addressed properly to reach its destination)

Associating the data packet with a network message (column 15, lines 53-60, Hamilton describes converting the received commands into suitable instructions)

Directing a network message to a command parser that executes a command contained in the network message (column 15, lines 53-60; Hamilton describes the commands being understood by the media server in order to executes them)

It would have been obvious to one of ordinary skill in the art at the time of invention to add this feature to the system taught by Birks in order to receive commands from a downstream receiver in a conventional way. Hamilton provides the motivation to receive commands from a customer in this way.

Claim 7 is rejected on the same basis as claim 6. As stated, Hamilton describes the process of receiving a signal from a downstream source, extracting a command from it, and converting this information into packets that are understood by the server.

Claims 17-18 are the apparatus claims to perform method claims 6-7, and are rejected on this basis.

10. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Birks et al, US PG PUB # 20030192054".

With regard to claim 10, Birks discloses:

The method of claim 9, wherein the step of directing the retrieved content to the downstream content receiver comprises the steps of: modulating a carrier signal according to the content stream; combining the modulated carrier signal with a multiple carrier signal; and conveying the combined signal to the downstream content receiver (Examiner takes *Official Notice* that using a multiple carrier signal to convey data is well-known and widely used in the art, and would have been obvious to one of ordinary skill in the art at the time of invention to employ.

Claim 21 is the apparatus to perform method claim 10, and is rejected on this basis.

### **Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK D. FEATHERSTONE whose

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telephone number is (571) 270-3750. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F US Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le, can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

E-Signed  
/Mark Featherstone/  
Art Unit 4157

/ABUL K. AZAD/  
Primary Examiner, Art Unit 2626